

PATENT

Atty. Docket No: 203-4027 (2944)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Todd L. Demmy et al.

EXAMINER: Ryan J. Severson

SERIAL NO.: 10/764,103

GROUP: 3731

FILED: January 23, 2004

DATED: April 10, 2008

FOR: SURGICAL STAPLING DEVICE WITH DISSECTING TIP

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PETITION TO ACCEPT AN
UNINTENTIONALLY DELAYED CLAIM UNDER 35 U.S.C. § 119(e)
FOR THE BENEFIT OF A PRIOR-FILED PROVISIONAL APPLICATION

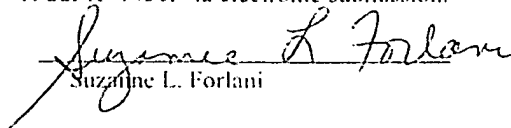
Sir:

Applicants respectfully request reconsideration of the Petition To Accept An Unintentionally Delayed Claim Under 35 U.S.C. § 119(e) For The Benefit Of A Prior-Filed Provisional Application filed on January 25, 2007 ("January 2007 Petition"). A copy of the January 2007 opinion is attached to this request as Exhibit A. The June 2007 Petition was dismissed in a decision mailed June 22, 2007 ("June 2007 decision") (Exhibit B). The June 2007 decision states the following:

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being transmitted on the date below with the United States Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450, via electronic submission.

Dated: April 10, 2008


Suzanne L. Forlani

"A petition under 37 CFR 1.78(a)(6) is only applicable to those applicants filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1017(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Additionally, the instant nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Further, the nonprovisional application claiming the benefit of the prior-filed provisional application must have been filed within twelve months of the filing date of the prior-filed provisional application.

The instant application is abandoned as of January 27, 2007 for failure to timely submit a proper reply to the Office action mailed October 26, 2006. Notice of Abandonment was mailed April 27, 2007."

Applicants submit that the January 2007 Petition satisfied each of the requirements specified in 37 CFR § 1.78(a)(6) as set forth above and was improperly dismissed. More specifically, the January 2007 Petition was accompanied by (i) an Amendment filed on January 25, 2007, a copy of which is attached hereto as Exhibit C, which included the reference required by 35 USC § 119(e) and 37 CFR § 1.78(a)(5)(i), and (ii) the surcharge of \$1,370.00 set forth in § 1.17(t). The January 2007 Petition also included a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(a)(5)(ii) and the date the claim was filed was unintentional. Furthermore, the January 2007 Petition was filed on January 25, 2007, during the

pendency of the above-identified application. More specifically, a one month extension of time (Exhibit D) was filed with the Amendment filed on January 25, 2007. Applicants note that Office Action (Exhibit E) to which Applicants failed to timely respond was mailed on October 19, 2006. Thus, the above-identified application did not go abandoned until February 19, 2007 (four months after the mailing date of the Office Action). As such, the January 2007 Petition was filed during the pendency of the above-identified application.

For the reasons outlined above, Applicants submit that the January 2007 Petition satisfied all the requirements of 37 CFR § 1.78(a)(6) and was improperly dismissed. Applicants respectfully request reconsideration.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefor.

Respectfully submitted,



Christopher G. Trainor
Reg. No. 39,517
Attorney for Applicant(s)

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road - Suite 225
Melville, New York 11747
(631) 501-5700
(631) 501-3526 (fax)

Correspondence Address:
Chief Patent Counsel
United States Surgical, a Division
of Tyco Healthcare Group LP
195 McDermott Road
North Haven, Connecticut 06473

EXHIBIT “A”

PATENT

Atty. Docket No: 203-4027 (2944)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Todd L. Demmy et al. EXAMINER: Ryan J. Severson

SERIAL NO.: 10/764,103 GROUP: 3731

FILED: January 23, 2004 DATED: January 25, 2007

FOR: **SURGICAL STAPLING DEVICE WITH DISSECTING TIP**

Mail Stop: Petition
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED
CLAIM UNDER 35 U.S.C. § 119(e) FOR THE BENEFIT OF
A PRIOR-FILED PROVISIONAL APPLICATION**

Sir:

Applicants hereby petition the Director to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of provisional application No. 60/466,378 ("378 application") which was filed on April 29, 2003. The entire delay between the date the claim was due under 37 C.F.R. § 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

Included with this petition are *i*) an amendment including the reference to the '378 application as required by 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78(a)(5) and *ii*) authorization to charge the deposit account no. 21-0550 for \$1,370.00 to cover the surcharge set forth in 37 C.F.R. § 1.17(t).

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 25, 2007.

Dated: January 25, 2007


Christopher G. Trainor

Please charge the surcharge of \$1,370.00 set forth in 37 C.F.R. § 1.17(t) and any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefor.

Respectfully submitted,



Christopher G. Trainor
Reg. No. 39,517
Attorney for Applicant(s)

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road - Suite 225
Melville, New York 11747
(631) 501-5700
(631) 501-3526 (fax)

Correspondence Address:

Chief Patent Counsel
United States Surgical, a Division
of Tyco Healthcare Group LP
195 McDermott Road
North Haven, Connecticut 06473

EXHIBIT “B”



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paul R. Audet, Esq.
United States Surgical,
a Division of Tyco Healthcare Group LP
150 Glover Avenue
Norwalk CT 06856

COPY MAILED

JUN 22 2007

OFFICE OF PETITIONS

| | | |
|--------------------------------------|---|-------------------------|
| In re Application of | : | |
| Demmy, et al. | : | |
| Application No. 10/764,103 | : | DECISION ON PETITION |
| Filed: January 23, 2004 | : | UNDER 37 CFR 1.78(a)(6) |
| Attorney Docket No. 2944 (203-4027) | : | |

This is a decision on the petition under 37 CFR 1.78(a)(6), filed January 29, 2007, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(i); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

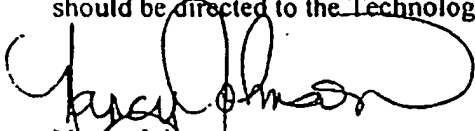
Additionally, the instant nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Further, the nonprovisional application claiming the benefit of the prior-filed provisional application must have been filed within twelve months of the filing date of the prior-filed provisional application.

The instant application is abandoned as of January 27, 2007 for failure to timely submit a proper reply to the Office action mailed October 26, 2006. Notice of Abandonment was mailed April 27, 2007.

Application No. 10/764,103

In view thereof, the instant petition is subject to dismissal.

Any inquiries concerning this decision may be directed to Alesia M. Brown at (571) 272-3205.
All other inquiries concerning either the examination procedures or status of the application
should be directed to the Technology Center.



Nancy Johnson
Petitions Attorney
Office of Petitions

EXHIBIT "C"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Todd L. Demmy et al.

EXAMINER: Ryan J. Severson

SERIAL NO.: 10/764,103

GROUP: 3731

FILED: January 23, 2004

DATED: January 25, 2007

FOR: **SURGICAL STAPLING DEVICE WITH DISSECTING TIP**

Mail Stop: Petition
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

Sir:

Please amend this application as follows:

Amendments to the Specification begin on page 2 of this paper.

Remarks/Arguments begin on page 5 of this paper.

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 25, 2007.

Dated: January 25, 2007


Christopher G. Trainor

Amendments to the Specification:

Please insert the following paragraph on page 1 of the specification prior to the section entitled BACKGROUND OF THE INVENTION:

CROSS REFERENCE TO RELATED APPLICATIONS

--This application claims priority from U.S. provisional application Serial No. 60/466,378 which was filed on April 29, 2003.--

Remarks

Claims 1-7 are currently pending in this application. By this amendment, the specification has been amended to claim priority to U.S. Provisional application Serial No. 60/466,378. No new matter has been added to this application.

Respectfully submitted,

Christopher G. Trainor

Christopher G. Trainor
Reg. No. 39,517
Attorney for Applicant(s)

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road - Suite 225
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(631) 501-5700
CGT:sf

Correspondence Address:
Chief Patent Counsel
United States Surgical, a Division
of Tyco Healthcare Group LP
195 McDermott Road
North Haven, Connecticut 06473

EXHIBIT “D”

Under the paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

CERTIFICATION UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service on date below as first class mail, postpaid in an envelope, addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: January 25, 2007

Christopher G. Trainor
Christopher G. Trainor

EXHIBIT "E"

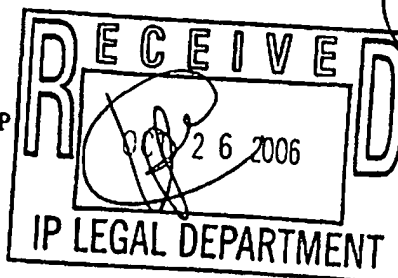


UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/764,103 | 01/23/2004 | Todd L. Demmy | 2944 (203-4027) | 7897 |

7590 10/19/2006
Paul R. Audet, Esq.
United States Surgical,
a Division of Tyco Healthcare Group LP
150 Glover Avenue
Norwalk, CT 06856



| EXAMINER | |
|------------------|--------------|
| SEVERSON, RYAN J | |
| ART UNIT | PAPER NUMBER |
| 3731 | |

DATE MAILED: 10/19/2006

Resp. to O. a. Due: Jan. 19, 2007

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/764,103 | DEMMY ET AL. | |
| | Examiner | Art Unit | |
| | Ryan Severson | 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/04/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Note to Applicant

1. It is suggested that all forms and amendments submitted from this point have the proper application number printed on each page to avoid confusion. Multiple previously submitted forms have application number 10/668,127 printed on them, which is an unrelated application.

Priority

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. 60/466,378, filed April 29, 2003. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date

on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

3. If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Oath/Declaration

4. Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

If the post office address is the *same* as the residence address, applicant is advised to state that it is the same in the proper blank on the declaration.

Information Disclosure Statement

5. The information disclosure statement filed October 4, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. The applications that have not been considered are lined out on the IDS.

Specification

6. The disclosure is objected to because of the following informalities: On page 10 of the specification, reference numerals 14a and 14b are used interchangeably to describe the inner and outer surfaces of the tip shown in figures 2-5 (see Lines 2, 3 and 23 on page 10).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

• The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll et al. (5,397,324). Carroll et al. reference discloses the invention substantially as claimed, including: a "dissecting tip" (32) engaged to an end effector at a proximal portion, a distal portion with a "first linear section" and a "second linear section," and a "curved transition section" interconnecting the linear sections. The first linear section is interpreted to be the linear surface of the tip (32) that does not extend beyond the distal tip of the cartridge section (see Figure 4). The second linear section is the linear surface of the tip (32) that extends beyond the distal tip of the cartridge section. The curved transition section is the portion that is curved on the opposite side of the tip from the linear sections and interconnects the linear sections as shown in Figure 4.

Regarding claim 2, the second linear section includes a blunt tip at its distal end (see the extreme left point of the tip in Figure 4).

Regarding claims 3 and 4, the tip is secured to an anvil assembly (2) of an end effector (see Figure 2) and extends distally beyond the distal end of the cartridge assembly (see Figure 4).

Regarding claim 5, the first and second linear sections each include flat inner surfaces, as the linear sections are the flat inner surfaces of the tip of Carroll et al. reference.

Regarding claims 6 and 7, the inner surface of the first linear section is parallel to and spaced from a "distal tissue guide surface" (8) when the tip is engaged to the end effector (see Figure 4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 10/764,103

Page 7

Art Unit: 3731

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ryan Severson
October 3, 2006



ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

10/15/06